

Remarks: Claims 1-25 and 37-39 are in condition for allowance

This is in response to the Office Action dated August 9, 2007. In the Office Action, Applicants' prior arguments were indicated to be persuasive, prosecution was re-opened, the prior rejections were withdrawn, the finality of the rejections was withdrawn, and new rejections were presented to claims 1-25 and 37-39.

With this amendment, Applicants amend claims 1, 2, and 9-12, respectfully submit that claims 1-25 and 37-39 are presently in condition for allowance, and request that the new rejections be reconsidered and withdrawn in light of the remarks herein.

Hsu does not anticipate claims 1 or 12 as amended

On page 2 of the Office Action, claims 1, 12, and 37 were rejected under 35 U.S.C. 102(e) with reference to U.S. Pat. No. 6,954,579 issued to Hsu. Claims 1 and 12 are amended herein. Applicants respectfully submit that Hsu does not anticipate claims 1 or 12 as amended.

In particular, claims 1 and 12 generally recite an electrically variable optical attenuator or attenuator system comprising a sensor or one or more sensors that provide a sensor output related to a variable sensed by the sensor that is at least one of temperature, wavelength, acceleration, or vibration (as more particularly defined by the specific wording of each of claims 1 and 12 respectively). Hsu does not disclose a sensor that senses any of temperature, wavelength, acceleration, or vibration, whether or not comprised in a variable optical attenuator, and therefore does not anticipate either of claims 1 and 12. Applicants therefore submit that claims 1 and 12 are novel over the cited reference, and respectfully request that the rejection of claims 1 and 12 be reconsidered and withdrawn.

Hsu does not anticipate claim 37

As noted above, page 2 of the Office Action also included a rejection of claim 37 based on purported anticipation by Hsu. However, the Office Action included no discussion directed to the specific subject matter recited by claim 37, and Applicants respectfully submit that claim 37 recites subject matter that is not disclosed by Hsu. For example, claim 37 recites a controller adapted to receive a value of an anticipated parameter, while Hsu does not make any disclosure of receiving a value of an anticipated parameter, but instead discloses sensing a present parameter, i.e. the changes in position itself as it occurs. Applicants therefore submit that claim 37 is novel over the cited reference, and respectfully request that the rejection of claim 37 be reconsidered and withdrawn.

Hsu and Sharp do not render obvious claims 2-11, 13-25, 38, or 39

On pages 3-4 of the Office Action, claims 2-11, 13-25, 38, and 39 were rejected under 35 U.S.C. 103(a) with reference to Hsu in combination with U.S. Pat. Application Publication No. 2003/0026581 filed by Sharp et al., and/or with purported common knowledge in the art. Applicants respectfully submit that claims 2-11, 13-25, 38, and 39 are not taught or suggested by the combination of Hsu and Sharp or purported common knowledge in the art, due at least to the novel and non-obvious aspects of their parent claims, as discussed above with reference to claims 1, 12, and 37, in addition to various novel and non-obvious aspects recited in the individual dependent claims.

Claims 1 and 12 as amended include subject matter not recited by either Hsu or Sharp. Additionally, the discussion of Sharp in the Office Action does not include any specific discussion of how either Hsu or Sharp might disclose the specific subject matter of claim 37 or its dependent claims. Therefore, Applicants respectfully submit that claims 2-11, 13-25, 38, and

39 are not made obvious by Hsu, Sharp, the purported common knowledge in the art, or a combination thereof.

Furthermore, while Sharp is used as a reference for a temperature sensor, the Office Action provides no reference for a sensor configured for sensing wavelength, acceleration, or vibration in the context of a variable optical attenuator, and therefore no basis either for why a person of ordinary skill in the art at the time of the present invention might have had the motivation to make the combinations claimed in the present claims, or for the recited combinations of elements to be taught or suggested by the references available to those in the art in the first place.

Additionally, even for elements that are indicated to be in a cited reference, such as a temperature sensor, the Office Action makes no distinction between the mere existence of the element in a cited disclosure, and the motivation to combine that element into the combination recited in the present claims. The mere existence of an element does not also constitute a universal rationale for motivating a person of ordinary skill in the art to combine that element together with another reference. As the U.S. Supreme Court has recently clarified, "A patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art." *KSR Int'l. Co. v. Teleflex Inc.*, 550 U. S. ____ (slip op. at 14), 127 S. Ct. 1727 (2007). This directly contradicts the assertion in the Office Action that the mere existence of certain elements in the dependent claims of the present application would motivate their combination into the subject matter of the recited claims.

Applicants respectfully submit that the Office Action's assertion of motivation to combine therefore relies on hindsight based on the knowledge gained in the present application, and makes no distinction between the mere existence of the indicated elements and a universal motivation to combine those elements in

the recited combinations. The Office Action also makes no specific assertion of why the claims are rejected for many of the claims, other than the unsupported assertion of various sensors being known in the art.

Applicants therefore respectfully request that the rejection of claims 2-11, 13-25, 38, and 39 also be reconsidered and withdrawn.

No narrowing interpretations implied

The foregoing remarks are intended to assist the Office in examining the application and in the course of explanation may employ shortened or more specific or variant descriptions of some of the claim language. Such descriptions are not intended to limit the scope of the claims; the actual claim language should be considered in each case. Furthermore, the remarks are not to be considered exhaustive of the facets of the invention which are rendered patentable, being only examples of certain novel features and differences, which Applicants have opted to comment on as illustrative examples.

Furthermore, in commenting on the references and in order to facilitate a better understanding of the differences that are expressed in the claims, certain details of distinction between the references and particular subject matter of the present application may have been commented on, even though such differences do not appear in all of the claims. It is not intended by commenting on any such distinctions to create any implied limitations in any particular claims of the present application.

Conclusion: Claims 1-25 and 37-39 are in condition for allowance

Applicants respectfully submit that claims 1-25 and 37-39 are patentable over the cited references for reasons set forth above. Applicants therefore respectfully request reconsideration

and withdrawal of the rejections of claims 1-25 and 37-39 and allowance of these claims.

The Director is authorized to charge any fee deficiency required by this paper or credit any overpayment to Deposit Account No. 23-1123.

Respectfully submitted,

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